REMARKS/ARGUMENTS

This amendment responds to the Office Action dated August 17, 2009, in which the Examiner objected to claims 4 and 9-11, and rejected claims 1-2, 4-6 and 8-11 under 35 U.S.C. § 103.

As indicated above, claims 4 and 9-11 have been amended to correct minor informalities. Applicants respectfully request the Examiner withdraws the objection to claims 4 and 9-11.

As indicated above, claims 1, 4 and 8-9 have been amended in order to make explicit what is implicit in the claims. The amendment is unrelated to a statutory requirement for patentability.

Claims 1 and 8 claim a recording system for recording and/or reserving a program. The recording system comprises a request accepting portion/means, a local storage/means, connection portion/means, determining portion/means and issuing portion/means. The accepting portion/means accepts a request to record and/or reserve a program. The local storage portion/means records the program. The connection portion/means connects, via a wide area network with an external device which is external to the recording system. The determination portion/means determines a failure in the recording system. The issue portion/means issues a recording substitution request, based on the determination result, to the external device via the wide area network to record the program in response to the determination portion/means determining the failure.

By having a determination means/portion determine a failure in the recording system and by having an issue mean/portion issue a recording substitution request based on the determination mean/portion determining the failure as claimed in claims 1 and 8, the claimed invention provides a recording system which allows a program to be recorded even when a

failure prevents the program from being recorded. The prior art does not show, teach or suggest the invention as claimed in claims 1 and 8.

Claims 4 and 9 claim a recording substitution system for substitutionally recording a program. The recording substitution system includes a connection portion/means for connecting via a wide area network with external devices. A receiving portion/means receives the program. A first storage portion/means records the program. A second storage portion/means stores customized program content. A recording substitution portion responds to reception of a recording substitution request from one of the external devices via the connection portion and receives and records a program corresponding to the request in the first storage portion/means. The recording substitution portion stores a recorded program stored in the first storage portion means and new advertising content received from another external device, in the second storage portion/means. The new advertising content is stored as a replacement or as an insertion for advertising in the recorded program.

By having a recording substitution mean/portion which (1) stores a program in a first storage means/portion and (2) either (a) stores advertising information for insertion into a recorded program or (b) stores the advertising information as a substitute for the original commercial information in the recorded program in a second storage portion/means as claimed in claims 4 and 9, the claimed invention provides a recording substitution system which will record a program with a personalized advertisement. The prior art does not show, teach or suggest the invention as claimed in claims 4 and 9.

Claims 1 and 2 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* (U.S. Patent No. 6,311,011) in view of *Ellis, et al.* (U.S. Publication No. 2003/0149988).

Kuroda, et al. appears to disclose in Figure 7 at step S107 determining if remaining capacity is sufficient. Thus, nothing in *Kuroda*, et al. shows, teaches or suggests determining a failure in the recording system as claimed in claim 1. Rather, *Kuroda* only discloses determining if capacity is sufficient. Applicants respectfully point out that even if capacity is not sufficient, the recording system has not failed and, in fact, can continue to record information.

Furthermore, *Kuroda*, et al. merely discloses displaying a dialog box which warns that the storage device does not have sufficient capacity and allows a user a choice to select another storage device. Nothing in *Kuroda*, et al. shows, teaches or suggests issuing a recording substitution request to an external device in response to the determination of the failure in the recording system as claimed in claim 1. Rather, *Kuroda* only discloses displaying a dialog box so that a user can select another device.

Ellis, et al. appears to disclose a remote media server 24 records programs and associated program guide data on storage 15 in response to record request generated by a program guide implemented on interactive program guide television equipment 17 in response to a user request [0084].

Thus, *Ellis, et al.* merely discloses a server 24 recording programs and guide data in response to request from an interactive television equipment 17 based on a user request. Nothing in *Ellis, et al.* shows, teaches or suggests issuing a recording substitution request in response to a determination means determining a failure in a recording system as claimed in claim 1. Rather, *Ellis, et al.* only discloses a server 24 recording a program in response to a request generated by a program guide television equipment based on a user request.

The combination of *Kuroda* and *Ellis, et al.* would merely suggest that when capacity is insufficient as taught by *Kuroda*, generating a warning to a user and to have a remote server

record programs as taught by *Ellis, et al.* Thus, nothing in the combination of the references shows, teaches or suggests determining a failure in the recording system and issuing a recording substitution request in response to the determination of the failure as claimed in claim 1. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 1 under 35 U.S.C. § 103.

Claim 2 depends from claim 1 and recites additional features. Applicants respectfully submit that claim 2 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda* and *Ellis, et al.*, at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 2 under 35 U.S.C. § 103.

Claims 4-6 and 9 were rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and *Zigmond, et al.* (U.S. Patent No. 6,698,020).

Kuroda appears to disclose in Figure 2 a temporary storage device 103 temporary stores content signals (column 4, lines 25-26) and a storage device 105 stores content signals according to a viewers direction (column 4, lines 38-39). Thus, nothing in *Kuroda* shows, teaches or suggests a first storage means for recording the programs and a second storage means for storing customized program content including a recorded program and advertising information inserted or substituted into the recorded program as claimed in claims 4 and 9. Rather, *Kuroda* only discloses a temporary storage device temporarily storing content signals and a storage device 105 storing content signals according to a viewers direction.

As discussed above, *Ellis, et al.* merely discloses a remote media server 24 records programs based upon a user indicating a program to record. Nothing in *Ellis, et al.* shows, teaches or suggests a first storage means recording a program when a recording substitution request is received and a second storage means for storing customized program content including

a recorded program and advertising information inserted into or substituted for original commercial information as claimed in claims 4 and 9. Rather, *Ellis, et al.* merely discloses a remote media server which records programs that a user wishes to record.

Zigmond, et al. appears to disclose selecting appropriate advertisements based on at least whether the video programming feed is watched as it is broadcast or being replayed from recorded media. Advertisers can update time sensitive advertisements when such advertisements have been recorded. Originally recorded on videotape or other recorded media can be replaced with effectively targeted ads based on any other desired criteria (column 14, lines 1-12). Advertisement repository 86 may comprise conventional magnetic tape or any other recorded media for storing an analog version of the video programming feed (column 15, lines 31-34).

Thus, *Zigmond, et al.* merely discloses an advertisement repository. Nothing in *Zigmond, et al.* shows, teaches or suggests (a) a first storage means for recording a program in response to reception of a recording substitution request and (b) a second storage means for storing customized program content including a recorded program and advertising information inserted into the recorded program or substituted for the original commercial information as claimed in claims 4 and 9. Rather, *Zigmond, et al.* merely discloses an advertisement repository.

A combination of *Kuroda*, *Ellis, et al.* and *Zigmond, et al.* would merely suggest that a user is prompted to select a storage device when a selected storage device contains insufficient capacity as taught by *Kuroda*, based upon a user's request issuing a request to record to a remote server as taught by *Ellis, et al.*, and to have an advertisement repository as taught by *Zigmond, et al.* Thus, nothing in the combination of the references shows, teaches or suggests the first and second storage means as claimed in claims 4 and 9 as discussed above. Therefore, Applicants

respectfully request the Examiner withdraws the rejection to claims 4 and 9 under 35 U.S.C. § 103.

Claims 5-6 depend from claim 4 and recite additional features. Applicants respectfully submit that claims 5-6 would not have been obvious within the meaning of 35 U.S.C. § 103 over *Kuroda*, *Ellis, et al.* and *Zigmond, et al.* at least for the reasons as set forth above. Therefore, Applicants respectfully request the Examiner withdraws the rejections to claims 5-6 under 35 U.S.C. § 103.

Claim 8 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* (U.S. Patent No. 5,805,763).

As discussed above, *Kuroda* merely discloses determining if there is sufficient capacity to record a program. As discussed above, having sufficient capacity is not a failure of the recording system as claimed in claim 8. Rather, having insufficient capacity in *Kuroda* merely means that the entire program will not be recorded but the recording system still functions.

Lawler, et al. appears to disclose a user can set a record tag by activating a record button 130 in a menu 136 (column 12, lines 29-32). When a record tag is set, it is stored at a head end 12. In this manner, the head end can monitor all the record tags set by the various system users (column 13, lines 8-12).

Thus, *Lawler, et al.* merely discloses having a user set a record tag and the system monitoring thereof. Nothing in *Lawler, et al.* shows, teaches or suggests determining a failure in a recording system and automatically issuing a record substitution request in response to the determination of the failure as claimed in claim 8. Rather, *Lawler, et al.* merely discloses a user setting a record tag and monitoring the tag by the system.

A combination of *Kuroda* and *Lawler, et al.* would merely suggest to determine if the system had sufficient capacity to record a program as taught by *Kuroda* and, in addition, to have the user set a record tag and to have the system monitor the tag as taught by *Lawler, et al.* Thus, nothing in the combination of the references shows, teaches or suggests determining a failure of a recording system and automatically issuing a record substitution request in response to the determination of the failure as claimed in claim 8. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 8 under 35 U.S.C. § 103.

Claim 10 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Ellis, et al.* and further in view of *Zigmond, et al.* Claim 11 was rejected under 35 U.S.C. § 103 as being unpatentable over *Kuroda* in view of *Lawler, et al.* and further in view of *Zigmond, et al.*

Applicants respe ctfully traverse the Examiner's rejection of claims 10 and 11 under 35 U.S.C. § 103. The claims have been reviewed in light of the Office Action and for reasons which will be set forth below, Applicants respectfully request the Examiner withdraws the rejection to the claims and allows the claims to issue.

As discussed above, since nothing in the reference to *Kuroda* shows, teaches or suggests the primary features as claimed in claims 1 and 8, Applicants respectfully submit that the combination in the primary reference with the secondary references to *Ellis, et al.*, *Zigmond, et al.* and *Lawler, et al.* will not overcome the deficiencies of the primary reference. Therefore, Applicants respectfully request the Examiner withdraws the rejection to claim 10 and 11 under 35 U.S.C. § 103.

Thus, it now appears that the application is in condition for a reconsideration and allowance. Reconsideration and allowance at an early date are respectfully requested. Should

the Examiner find that the application is not now in condition for allowance, Applicants respectfully request the Examiner enters this Amendment for purposes of appeal.

CONCLUSION

If for any reason the Examiner feels that the application is not now in condition for allowance, the Examiner is requested to contact, by telephone, the Applicants' undersigned attorney at the indicated telephone number to arrange for an interview to expedite the disposition of this case.

In the event that this paper is not timely filed within the currently set shortened statutory period, Applicants respectfully petition for an appropriate extension of time. The fees for such extension of time may be charged to Deposit Account No. 50-0320.

In the event that any additional fees are due with this paper, please charge our Deposit Account No. 50-0320.

Respectfully submitted,

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